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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/446,314	12/20/1999	Yasumasa Yamakoshi	0216-0429P	2146
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EXAMINER ZEMEL, IRINA SOPHIA				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
09/22/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

09/446,314

Applicant(s)

YAMAKOSHI ET AL.

Examiner

Irina S. Zemel

Art Unit

1796

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7-18-2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kusano in combination with Encyclopedia.

The rejection of claim 1 stands as per reasons of record. Insofar as newly added limitation of claim 8, the claims is still written in a –product-by-process format, thus the patentability of the claimed product depends only on the product characteristics. As discussed in the previous office actions, since it would have been obvious to use steps of centrifugal dehydration similar to the centrifugal dehydration disclosed a suitable in the instant specification in the process disclosed in Kusano, there is a reasonable believe that the products obtained by such method would have been patentable indistinguishable from the product as claimed. The burden is shifted to the applicants to provide factual evidence as t the patentable differences of the claimed product and the obvious products obtained by the process of Kusano (or as modified in view of Encyclopedia).

Claims 2-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kusano in combination with US Patent 4,423,207 to Flock et al., (hereinafter "Flock").

The rejection stands as per reasons of record. The newly added limitation, i.e., negative limitation precluding mechanical compression dehydration, is still met by the combined teachings of the cited references, as the claimed steps would have been

obvious to substitute for the steps of Kusano as per discussion in the previous office action, and the product obtained by such modified process would have been at least obvious as a necessary result of an obvious process.

Response to Arguments

Applicant's arguments filed 6-18 and 7-18-2008 have been fully considered but they are not persuasive.

The applicants arguments are directed to the claims as amended, i.e., limitations of claims 2 and 8 that further distinguish the claimed invention and the invention disclosed in illustrative examples of Kusano. It is noted, once again, that the broad disclosure of Kusano expressly discloses centrifugal dehydration. The examiner agrees, however, with the applicants that the invention disclosed in illustrative examples of Kusano is different from the claims process of claims 2-7 to the extent that the dehydration step in illustrative examples of Kusano is performed using a mechanical compression type dehydrator, now excluded from the claimed step 3.

It is specifically noted that this is the ONLY difference between the claimed process and the process disclosed in illustrative examples of Kusano.

The claimed dehydration steps are well known in the art of polymer chemistry and general chemistry. Separation of solids and liquids is done by various techniques that are learned by an ordinary artisan in the first year of chemistry and is a text-book known as evidenced from cited reference, i.e., Encyclopedia. Specific separation of polymers from liquids is also known to be performed via different techniques, including

compression mechanical dehydration as well as claimed filtration/gravity dehydration. The examiner cited the secondary references that show equivalence of such dehydration steps in application of polymer/liquid separation. The applicants argue that the reference, Flock, showing such equivalency, does not show dehydration of porous polymers, rather it shows dehydration of hard engineering plastics, and, therefore, is inapplicable to porous polymers. This argument is not persuasive at all. The secondary reference is cited for general teachings of known solid/liquid separation techniques. This method is expected to be applicable for any solid/liquid separation (and all of those methods are widely known in chemical art), including rubbery polymers or engineering plastics. The proposed substitution of one known method for another is no more than a use of known technique to improve similar devices (methods, or products) in the same way; or applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; which rationale of obviousness is fully consistent with the decision of *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1395-97 (2007).

Therefore, the examiner is still of the opinion that a strong prima facie case of obviousness of the claimed invention over the cited references has been established.

Now the question is whether this step, which is clearly obvious from the disclosure of Kusano and the secondary cited references, produced unexpected results that can rebut the established prima facie case of obviousness for the process and show clearly and convincingly that the product obtained by this process is patentably

distinct (and/or unexpectedly improved) from the product obtained by the process of Kusano.

Evidence pertaining to secondary considerations must be taken into account whenever present; however, it does not necessarily control the obviousness conclusion. See, e.g., *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1372, 82 USPQ2d 1321, 1339 (Fed. Cir. 2007) ("the record establish [ed] such a strong case of obviousness" that allegedly unexpectedly superior results were ultimately insufficient to overcome obviousness conclusion); *Leapfrog Enterprises Inc. v. Fisher-Price Inc.*, 485 F.3d 1157, 1162, 82 USPQ2d 1687, 1692 (Fed. Cir. 2007) ("given the strength of the *prima facie* obviousness showing, the evidence on secondary considerations was inadequate to overcome a final conclusion" of obviousness); and *Newell Cos., Inc. v. Kenney Mfg. Co.*, 864 F.2d 757, 768, 9 USPQ2d 1417, 1426 (Fed. Cir. 1988).

Once again, the examiner is not convinced that the results presented on the record are sufficient to rebut the strong *prima facie* case of obviousness as established on the record.

In establishing allegedly unexpected results the applicants compare illustrative example 1 and 6 and comparative example 5.

The applicants argue that the only difference between example 1 and comparative example 5 is a method of dehydration. This is not so as the drying method is also different. Insofar as example 6, not only the drying method is different, the actual procedure of obtaining the slurry is also slightly different. In addition, such results are only shown for a very narrow embodiment (specifically only one polymers with specified

Mw and S/B ratio) while the claimed invention encompasses the entire universe of hydrogenated A/D polymers and no evidence that the allegedly unexpected results would be the same across the boards, for example, for lower molecular weight polymers having higher D content.

Further, there is absolutely no evidence that the example of Kusano does not produce the results similar to the claimed oil absorbency results. In fact, as evidence from the disclosure of Kusano, the porous polymer obtained by the method of his invention results in polymer of very good absorbency and appearance.

Thus, the applicants did not provide any evidence to the patentable distinction of the porous product as obtained by the process of Kusano and as claimed.

Applicant's arguments with respect to claims 2-7 to the process have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ Irina S. Zemel/
Primary Examiner, Art Unit 1796

Irina S. Zemel
Primary Examiner
Art Unit 1796

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